

REMARKS

In the July 28, 2004 Office Action, the Examiner:

- Rejected claim 1 under 35 U.S.C. 103(a) as unpatentable over *Bostick* (“Bostick”, U.S. Pat. No. 5,074,272) in view of *Kushida* (“Kushida”, U.S. Pat. No. 5,626,121); and
- Rejected claims 2-3 under 35 U.S.C. 103(a) as unpatentable over *Kushida* in view of *Bostick* and *Melchior* (“Melchior”, U.S. Pat. No. 5,199,402).

Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected claim 1 under 35 U.S.C. 103(a) as unpatentable over *Bostick* in view of *Kushida*, and further rejected claims 2-3 as unpatentable over *Kushida* in view of *Bostick* and *Melchior*. To establish a prima facie case of obviousness, three basic criteria must be met, namely:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure.¹

The Examiner states that *Bostick* teaches using a shunt valve to bypass a fuel return pressure valve. The Examiner further states that *Kushida* teaches the claimed details of Applicant's spring based regulator and bypass valve.

Independent claim 1 requires:

a regulator . . . including: a housing forming . . . a fuel inlet formed at one side of said chamber, a fuel outlet formed at said valve seat . . . ; and

¹ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

a bypass channel directly connecting said fuel inlet and said fuel outlet of said regulator . . . (Emphasis added).

In other words, the claim requires that the bypass channel directly connects the fuel inlet with the fuel outlet formed at the regulator valve seat. While *Kushida* teaches a high-pressure side inlet port 12 and a valve regulator seat member 56, *Kushida* does not teach a bypass channel directly connecting a fuel inlet to a fuel outlet at the regulator valve seat. Accordingly, *Kushida* (with or without *Bostick*) does not teach or suggest all the claim limitations of Applicant's spring based regulator and bypass valve. For this reason alone, independent claim 1 cannot be obvious over the combination of *Kushida* and *Bostick*.

Moreover, *Kushida* teaches a solenoid valve 9, which is provided across the high-pressure side passage 53 and the low-pressure side passage 54. At the time of starting the engine 16, the solenoid 64 of the solenoid valve 9 is turned ON to communicate the high-pressure side passage 53 and the low-pressure side passage 54, thereby enabling delivery of pressurized fuel from the low-pressure feed pump 3, not from the high-pressure gasoline pump 4, so that low-pressure fuel can be used during engine starting. See *Kushida* col. 5, lines 22-26. In other words, The solenoid valve 9 disclosed in *Kushida* is opened when the engine is turned ON. This is completely unlike the present claimed invention which bypasses the regulator when the engine is turned OFF. Accordingly, *Kushida* explicitly teaches away from the combination with *Bostick* that is suggested by the Examiner. For this reason alone, there is no suggestion to modify *Kushida* or to combine its teachings with those of *Bostick*.

In light of the above, claim 1 cannot be unpatentable over *Bostick* in view of *Kushida*, as the prior art references do not teach or suggest all of the claim limitations. Similarly, dependent claims 2-3 cannot be unpatentable over *Kushida* in view of *Bostick* and *Melchior*, as the prior art references do not teach or suggest all of the limitations of independent claim 1 from which they depend.

New Claims

Applicants have added new claims 4-8 for matter previously claimed. No new matter has been added.


CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is now in a condition for allowance. However, should the Examiner believe that the claims are not in condition for allowance, the Applicant requests the Examiner call the undersigned attorney at 650-843-7519 to set up an interview.

If there are any fees or credits due in connection with the filing of this Amendment, including any fees required for an Extension of Time under 37 C.F.R. Section 1.136, authorization is given to charge any necessary fees to our Deposit Account No. 50-0310 (order No. 060945-0131-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

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